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09/766,438	01/19/2001	Steven Barritz	P/3704-5	7163
2352	7590	06/06/2005	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/766,438

**Applicant(s)**

BARRITZ ET AL.

**Examiner**

Khanh H. Le

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/30/04
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8-20, 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-20, 22-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **Detailed Action**

1. This Office Action is responsive to the Response dated December 30, 2004. Claims 1- 42 were pending in the present application. Claims 5,7 and 21 are canceled. All amendments are entered. Presently presented are claims 1-4, 6, 8-20, 22- 42. Claims 1, 39 are independent.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 1 and all its dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

As claimed in claim 1, it is unclear whether there are two distinct facilities to collect and gather viewers' profiles since they seem to perform the same function. The same question arises with the facilities to control program and advertising delivery. Appropriate correction is required.

### **Response to Arguments**

4. In view of the amendments , previous rejections of claims 1, 2-4, 12-14, 17-19, 25-26, 28, 31-32, 34, 36, 37, 39-41 under 35 U.S.C. 102(b) as being anticipated by Wachob, US 5155591 are withdrawn. New rejections apply.

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In view of the amendments , previous rejections of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Wachob in view of Scroggie, U.S. 6,014,634, are withdrawn. New rejections apply.

In view of the amendments , previous rejection of claims 5, 6-10, 21-24 under 35 U.S.C. 103(a) as being unpatentable over Wachob in view of Garg et al., US 6571216 B1, herein Garg are withdrawn as moot or replaced by other art rejections.

As to claim 39, at page 11, last 2 paragraphs, Applicants argue Wachob cannot operate with over the air public broadcasting systems because of the limited bandwidth spectrums assigned to public TV entities such as ABC, CBS, NBC etc. However this is not a technical problem, it's a problem of the current commercial and/or regulatory environment and is not related to the determination of obviousness as it does not involve any technological incompatibility. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193 (CA FC 1983) "Fact that two disclosed apparatuses would not be combined by businessmen for economic reasons is not same as saying that it could not be done because skilled persons in art felt that there was some technological incompatibility that prevented their combination; only latter fact is telling on nonobviousness issue." The previous rejections are maintained.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**6. Claims 1, 2-4, 6, 8, 10-14, 17-19, 22, 24-26, 28, 31-32, 34, 36, 37, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachob, US 5155591 in view of Logan et al, US 5721827.**

As to claims 1, 39-41, Wachob discloses:

A public broadcasting system involving broadcasting of live program content divided into segments with intervals separating the segments and advertising content provided in the intervals, the system comprising:  
a broadcasting facility (see at least Fig. 1 “head-end” and associated text)

for broadcasting the live program content and a plurality of receiving devices for receiving the live program content (see at least col.1 lines 27-30) and for playing the live program content to viewers substantially without delay;

advertising players (see at least Fig. 1 ,item 10 and associated text)  
coupled with corresponding ones of the receiving  
devices, the advertising players including a facility for receiving and pre-storing the  
advertising content; and

an advertising content inserter operable with the advertising inserter and  
the receiver for dynamically and interactively inserting portions of the pre-stored  
advertising content into the live program content being provided to viewers, in a manner  
that the pre-stored advertising content and the live program content are presented in  
integrated form to viewers (see at least abstract, Fig. 1 and associated text);

an interface facility that enables viewers to provide viewer profile data to broadcasters  
(see at least Fig 2, remote control, and associated text)  
; and

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a facility in the advertising content inserter (see at least col. 6 lines 46-67, the “converter”) that selects segments from the pre-stored advertising to be inserted in the live broadcast based on viewer profile data of respective viewers (see at least abstract, Fig. 1 and associated text) .

As to the new limitations, Wachob does not disclose however Logan discloses (see at least abstract, cols. 9-10, 25-26, Figs. and associated text)

“a facility that sets rewards to viewers based on criteria that is associated with the viewer profile data provided by viewers (Logan’s viewers state how much advertising they are willing to experience, which fact is part of their profile, and the system sets different rewards based on the different criteria of those profiles, the rewards being more free content for experiencing more ads; in other words in Logan, the reward is the free programming to watch/listen to; the profile specifies a number of ads to watch which determines a ratio or rate for rewards, i.e. a customer A gets benefit 1 (X minutes of free programming) for watching Y number of ads while customer B gets benefit 2 (Z minutes of free programming) for watching a different number of ads) ;  
and

a control which responds to the rewards set by the rewards facility, in a manner which adjusts the durations of the program content and the durations of the advertising content being provided to the different ones of said viewers based on their corresponding viewer profile data : (in Logan, the respective durations of the program content and the advertising content are adjusted according to the formulas as discussed above) .

It would have been obvious to one skilled in the art at the time the invention was made to add those features of Logan to Wachob to allow subsidizing desirable content as taught by Logan.

As to claims 2-4 (dependent on claim 1), Wachob discloses the broadcasters include point-to-one, point-to-few, point-to-many

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broadcasters (cable TV can broadcast to an audience of one, of few, or of many).

As to claims 6, 8, 10, 22, Logan at least implicitly discloses the respective claimed limitations with respect to the rewards due to the nature of the targeted ads disclosed in Logan. The motivation to combine Logan to Wachob has been discussed above.

As to claim 11 (dependent on claim 1), Wachob does not specifically but Logan does disclose the viewers profile data is provided by viewers in accordance with different levels of specified viewer profile detail (users can specify more preferences). It would have been obvious to one skilled in the art at the time the invention was made to add this additional feature taught by Logan to Wachob to enable providing better targeted ads as taught by Logan.

Note that the limitation "so to enable providing different reward levels" is a statement of intended use, does not affect the method step and therefore is not accorded patentable weight.

As to claims 12-14 (dependent on claims 1 and 12), Wachob discloses the insertion of the alternate advertising is effected at an interface facility which is a central facility which is operated outside of viewers' homes (see at least col. 8 lines 67 to col. 10 lines 19 ; Figs. 5 and 6 and associated text) or is a gathering device (see at least Fig. 1, "inserter" and associated text).

As to claim 17 (dependent on claim 14) Wachob discloses the gathering device comprises internal storage for storing program content and a facility that plays program content after a delay (see at least Fig. 5, item 60, and associated text: item 60, the inserter can be a VCR ).

As to claims 18-19 (dependent on claim 12), Wachob discloses the interface facility comprises a device located in the home of the viewer. from a group consisting of setup box, descrambler, VCR, GD, PTV, television receiver, Web browser and Internet appliance (see at least Figs 1, 5 and associated text).

As to claim 24 Logan at least implicitly discloses the rewards are a reduction of the frequency of commercials when the profile indicates less inclination to experience them. The motivation to combine Logan to Wachob has been discussed above.

As to claim 25 (dependent on claim 1), Wachob discloses the viewer profile information is communicated to broadcasters via viewer responses to questionnaires. (see at least col. 1 lines 56-58: "surveys").

As to claim 26 (dependent on claim 18), Wachob discloses the viewer profile information is communicated to broadcasters via remote controller messages transmitted to the respective interface facility located at the respective homes of the viewers (see at least col. 1 lines 49-51).

As to claim 28 (dependent on claim 1) Wachob discloses the viewer profile information is communicated to the broadcasters (see at least col.1 lines 48-64).

As to claims 31-32 (dependent on claim 1), Wachob discloses a facility that selects either the program content or the alternate advertising by Cable TV or satellite signals transmitted to addressable converters or by signals transmitted over the air (see at least col. 1 lines 10-14).

As to claims 34, 36 and 37 (dependent on claim 1), Wachob discloses a facility that identifies viewers who are actually viewing program content (see at least col. 3 lines 1-10), detects viewers' presence near a television set (see at least col. 6 lines 11-15), via a remote controller device operable by the viewers (see at least col. 3 lines 1-10).



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**7. Claims 15, 16, 20, 27, 29-30, 33, 35, 38, 40, and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Wachob and Logan as applied to claims 14 above, and further in view of Herz et al., US 6088722, herein Herz.**

As to claim 15 (dependent on claim 14), Wachob does not specifically disclose the gathering device incorporates internal cellular telephone circuitry that automatically communicates with the broadcasters though it discloses telephone circuitry to do the same (see at least col. 8 lines 51-54; col. 10 lines 36-42). Herz, in the same art discloses however that such wireless substitute is well-known.

*Consider Herz: "Two main hardware implementations for data collection are described herein with reference to the preferred two-way embodiment: telephone system return and CATV system return. Both of these approaches utilize a "wired" return path for data collection. In addition, those skilled in the art will appreciate that several wireless alternatives for data collection are possible. The specific implementation selected depends upon several variables, including the technology in place on the CATV or conventional over air broadcast system, specific polling techniques employed, telephone system flexibility, the required/desired frequency for polling the data, and the level of maintenance employed on the CATV or conventional over air broadcast system. Details of a telephone system implementation are highlighted in FIGS. 5 and 6."*

It would have been obvious to one skilled in the art at the time the invention was made to add such wireless capabilities as taught by Herz to Wachob depending on the technology in place as taught by Herz above.

As to claim 16 (dependent on claim 15), Wachob does not disclose internal cellular telephones associated with a plurality of viewers are operated as party line telephones. However, Official Notice is taken that it is well-known to use party line telephones when plural users are

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involved. It would have been obvious to one skilled in the art at the time the invention was made to add such feature to for the above stated advantage.

As to claim 20 (dependent on claim 1), Wachob does not disclose the broadcasters comprises a video-on-demand provider. However Herz does discloses such as parallel to the cable broadcasters as an alternative provider. It would have been obvious to one skilled in the art at the time the invention was made to add Herz to Wachob for the advantage as cited by Herz.

As to claim 27 (dependent on claim 1) Wachob does not disclose the viewer profile information is communicated to the broadcasters via the Internet or through authorized release of data from financial institutions. Official Notice is taken that it is well-known to use the Internet or authorized releases of data from financial institutions to provide profiles. Therefore it would have been obvious to one skilled in the art at the time the invention was made to add these alternate well-known methods of gathering profile information as Wachob discloses using alternate methods of profiling viewers (see at least col. 1 lines 56-62).

As to claim 33 (dependent on claim 1), Wachob does not disclose an encryption software that encrypts viewers' profile information provided by viewers. However, Official Notice is taken that it is well-known to use encryption on consumers profile information to protect consumer privacy. It would have been obvious to one skilled in the art at the time the invention was made to add such feature to Wachob for the above stated advantage.

As to claim 35 (dependent on claim 34) Wachob does not disclose the facility that identifies viewers includes a voice recognition facility. However, Official Notice is taken that it is well-known to use voice recognition to passively detect user experiencing programs/ads to monitor the effect of the content/ads on users. It would have been obvious to one skilled in the art at the time the invention was made to add such feature to Wachob for the above stated advantage.

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As to claim 38 (dependent on claim 1), Wachob does not specifically disclose a central entity that manages viewer profile information in a manner that protects the confidentiality of viewers identities from the broadcasters. However, Official Notice is taken that it is well-known to protect consumers profile information to protect consumer privacy. It would have been obvious to one skilled in the art at the time the invention was made to add such feature to Wachob for the above stated advantage.

As to claims 29, 30 (dependent on claim 1) Wachob does not specifically disclose a facility that selects either the program content or the alternate advertising by means of a server database and by downloading over the Internet. However, in the analogous art, Herz discloses downloading of programs via Internet and thereby suggests use of server database (see at least col. 52 lines 40-50). It would have been obvious to one skilled in the art at the time the invention was made to add Herz's internet storage/ downloading methods to Wachob to extend Wachob's storage/serving capabilities as suggested by Herz.

As to claim 42 (dependent on claim 39), Wachob does not specifically disclose the broadcasters include a radio broadcaster. However, Herz discloses the video, cable broadcasting embodiments are extendable to radio ones (see at least col. 52 lines 30-45). It would have been obvious to one skilled in the art at the time the invention was made to add radio to Wachob as Wachob had suggested equivalent broadcasting systems can be used with his invention.

#### **8. No art rejections as to Claims 9 and 23**

As to claim 9, (dependent on claim 1) none of the art of record alone or in combination fairly discloses the combination as claimed "in which the rewards comprise the replacement of the commonly provided advertising content with brief program material".

As to claim 23. (dependent on claim 1) none of the art of record alone or in combination fairly discloses the combination as claimed "in which the rewards comprise a combination of advertisements in advertising pods".

### Conclusion

9. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37.CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov). ( However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. (After our Art Unit moves to the Alexandria campus, sometime during or after April 2005, the Examiner's phone number will be 571-272-6721 and Mr. Eric Stamber's will be 571-272-6724. The current numbers are still in service until the move). The fax phone numbers for the organization where this application or

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proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

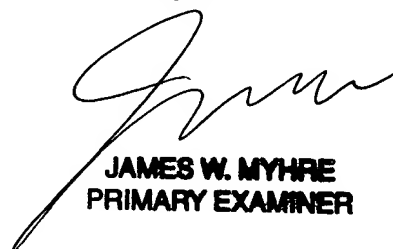
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

May 27, 2005

KHL

*KHL*

~~PRIMARY EXAMINER~~  
~~JAMES W. MYHRE~~

  
JAMES W. MYHRE  
PRIMARY EXAMINER